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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.          | CONFIRMATION NO. |
|--|-------------|----------------------|------------------------------|------------------|
| 10/706,711   | 11/12/2003  | Guillaume Cassin     | LOREAL 3.0-046;<br>OA02360/E | 9477             |
| 530  | 7590        | 07/15/2009           | EXAMINER                     |                  |
| LERNER, DAVID, LITTENBERG,<br>KRUMHOLZ & MENTLIK<br>600 SOUTH AVENUE WEST<br>WESTFIELD, NJ 07090 |             |                      | FUBARA, BLESSING M           |                  |
|  |             |                      | ART UNIT                     | PAPER NUMBER     |
|  |             |                      | 1618                         |                  |
|  |             |                      | MAIL DATE                    | DELIVERY MODE    |
|  |             |                      | 07/15/2009                   | PAPER            |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                                       |  |  |
|------------------------------|---------------------------------------|--|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/706,711  | <b>Applicant(s)</b><br>CASSIN, GUILLAUME |  |
|                              | <b>Examiner</b><br>BLESSING M. FUBARA | <b>Art Unit</b><br>1618                  |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 April 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3-5,8-23,25-35 and 37-46 is/are pending in the application.
- 4a) Of the above claim(s) 3-5 and 14-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,8-13,23,25-35 and 37-46 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

Examiner acknowledges receipt request for reconsideration and remarks filed 4/13/09.

No claim is amended. Claims 1, 3-5, 8-23, 25-35 and 37-46 are pending and of these, claims 3-5 and 14-22 are withdrawn from consideration.

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 8-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
3. Claim 8 recites 2-acrylamido-2-methylpropane sulfonic acid (AMPS) derivatives and the boundaries of the AMPS derivatives is not defined.

Applicant may recite what exactly are the disclosed AMPS derivatives

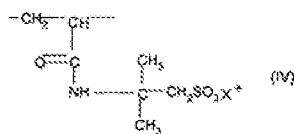
### ***Response to Arguments***

4. Applicant's arguments filed 04/13/09 have been fully considered but they are not persuasive.

Applicant argues that a section pages 11-14 of the specification describes what hydrophobic AMPS derivatives are and that specifically paragraph [0059] on page 13 shows formula (IV), a specific AMPS derivative and page 14 showing formula (V), which is also a specific hydrophobic AMPS derivative having at least one ethylenically unsaturated monomer

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that comprises at least one hydrophobic portion. The examiner disagrees that page 11-14 of the as filed specification describes or defines 2-acrylamido-2-methylpropane sulfonic acid (AMPS) derivatives. (A) AMPS is 2-acrylamido-2-methyl-propane sulfonic acid (AMPS). (B) Pages 11-14 of the as filed specification do not state what the derivatives of AMPS are. (C) Secondly, formula (IV)



is 2-acrylamido-2-methyl-propane

sulfonic acid (AMPS) and is not a derivative of 2-acrylamido-2-methyl-propane sulfonic acid (AMPS). Paragraph [0059] states: "Mention will be made more particularly of the copolymers consisting of:" a, which is formula (IV) and b, which is formula (V) and there is no mention that formulae (IV) and (V) are derivatives of AMPS. Therefore, the specification has not listed or named what the derivatives of hydrophobic AMPS are and the boundaries of the derivatives of AMPS is defined. Applicant's arguments appear to indicate that the copolymer of formula (IV) and (V) is a derivative of AMPS, but, the specification has not specifically stated that the copolymer of (IV) and (V) is a derivative of hydrophobic AMPS. Furthermore, the recitation of cross-linked or non-crosslinked amphiphilic polymers of AMPS is not a statement for derivatives of AMPS derivatives.

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 8-13, 23, 25-35 and 37-42 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Dubief et al. (US 6,090,376) for reasons of record and reiterated herein below.

7. Dubief discloses composition comprising at least one grafted silicone polymer in particle form dispersed in aqueous medium, amphiphilic polymer (abstract; column 1, lines 32-43; column 2, lines 21-27; column 5, lines 28-30; column 7, lines 5-7), water (column 6, line 64), vegetable, animal or synthetic oils or vitamins or surfactants (column 7, lines 8-13). The composition comprising the amphiphilic polymer, the grafted silicone polymer meeting the limitation of tensioning polymer of claim 1, water and oil meets claims 1 and 33. The amphiphilic polymer is used in amounts of between 0.01 to 20 wt% (column 6, lines 59-62) and the amphiphilic polymer can be based on acrylic polymers (column 5, line 60 to column 6, line 56) with the acrylic polymers meeting claim 8-13. Exhibiting "a retraction of isolated stratum corneum ... in water is a property/characteristic of the tensioning polymer and the tensioning polymer of Dubief would have the same property/characteristic. Claim 1 requires that the surfactant be present at amounts of less than 1% by weight relative to the total composition and the suggestion by Dubief that the additive surfactant be present at amounts of 0-20, with the lower limit of 0 being less than 1% suggestive that an amount of less than 1% can be used so that that limitation brought from original claim 24 into claim 1 is met. The requirement that the surfactant be different from the amphiphilic polymer is also met because, Dubief discloses composition containing amphiphilic polymer, surfactant.

Claims 11, 12 and 23, 25-32 recite the amounts of the acrylic polymer/ionic amphiphilic polymer, tensioning polymer, fatty phase, surfactant and water. Dubief does not teach the exact amounts recited in those claims. The amount of the ionic amphiphilic polymer of Dubief at 0.01 to 20 wt% (column 6, lines 59-62) encompasses the claimed amount of the ionic amphiphilic polymer or acrylic polymer. While Dubief suggests the use of additive surfactant polymer at 0-20%, Dubief does not specifically relate the amount of the surfactant to the total weight of the composition, and while these amounts are not exactly the same as those recited in the claims, the amounts recited in the claims would have been obvious because the person of ordinary skill in the art would have good reason to use various components of the composition in amounts that would provide composition that when applied to hair would effectively treat the hair as regards entangling/disentangling and smoothness and styling and feel. In the absence of unexpected results, the amounts recited in those claims are not inventive over the teaching of Dubief.

### ***Response to Arguments***

8. Applicant's arguments filed 4/13/09 have been fully considered but they are not persuasive.

9. i) applicant argues against the examiner's response in paragraph 10, page 5 of the office action of 01/08/09 to applicant's argument of 10/08/08, cites column 2, lines 16-26, column 9, lines 52-63 and column 4, lines 46-54 of Dubief and concludes that the silicone polymers of Dubief "are composed of an organic main chain formed from monomers not containing silicone polymers having main silicone chain." The examiner disagrees with the applicant that the silicone polymer of Dubief does not have silicone in the main chain, while applicant insists on the process of making the grafted silicone polymer, the examiner notes that the claims are not

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directed to how the grafted silicon is made but rather that the claim 1 is composition in which grafted silicone polymer having a main silicon chain is one of the polymers for the tensioning polymer. Column 2, lines 16-26 is a preferable composition of the silicone polymer and the Dubief art is not limited to the preferred embodiment. For example, column 2, lines 54-67 describes specific family of silicone polymers comprising grafted silicone copolymers that comprises polysiloxane macromer; the macromers used for the formation of the grafted silicone are shown in column 4, lines 5-44 and the structures all have silicone in the polymer chain. Further, the grafted silicone polymer of structure (I) (column 2, line 66, column 7, line 64; column 8, lines 5-16) have silicon in the main chain. Also, while Dubief discloses the grafted silicone polymer can be prepared from non-silicone organic skeleton (claim 1 at column 9, line 57), the non silicone containing organic skeleton is not the only reagent in the formation of the grafted silicone polymer, but the other reactant contains silicone. Applicant appears to acknowledge that Dubief teaches grafted silicone polymer while at the same time takes away the silicone from the grafted silicone polymer, and a silicone polymer must have silicone. It is noted, with regards to column 4, lines 46-64 argued by applicant to exclude silicone, that column 4, lines 5-45 describes the production of grafted silicone polymers from monomers that include monomer having silicone in the main chain and grafted silicone polymer is produced from the reactants. Therefore, the grafted silicone polymer of Dubief has silicone in the main chain of the polymer and the rejection is maintained. The operability of Dubief is not destroyed because a modification of Dubief is not only required for the amounts of the surfactant.

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10. Claims 1, 8-13, 23, 25-35 and 37-42 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Dubief et al. (US 6, 090,376) in view of Nandagiri et al. (US 5,362,486) for reasons of record and reiterated herein below.

11. Claim 1 has been described above as obvious over Dubief using grafted silicone polymer. Dubief discloses composition comprising ionic amphiphilic polymer, tensioning polymer, water and oil as described above. The composition of Dubief is applied to the hair for treatment (abstract). The tensioning polymer of Dubief is a grafted silicone interpenetrating polymer as stated above. Dubief does not teach polyurethane and polyacrylic as tensioning polymer as recited in amended claim 1 as one of the choices for the polymer. However, Nandagiri discloses composition comprising polyurethane-acrylate for bodifying hair (column 15, lines 13-62). Therefore, taking the two references together, it would have been obvious to use the polyurethane-acrylate tensioning interpenetrating polymer of Nandagiri in the composition of Dubief and expect to have a composition for treating hair as it relates to body, feel, styling and disentangling of the hair.

12. Applicant has not addressed the rejection of the claims over Dubief in view of Nandagiri in the response filed 04/13/09.

13. Claims 1 and 43-46 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Dubief et al. (US 6, 090,376) in view of Daiko et al. (US 6,846,812) for reasons of record and reiterated herein below.

Dubief uses composition containing grafted silicone to treat hair or keratinous substances (abstract) as described above. Dubief does not teach using the composition containing grafted



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silicone to treating/smoothening wrinkled skin or restoring skin tautness. But composition containing grafted silicone is known to have the capability of fading out irregularities of the skin such as wrinkles and fine lines according to Daiko (column 6, lines 3, 4, 14 and 27; column 10, lines 60-62; column 11, lines 29-45; column 12, lines 50-53). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to apply the composition of Dubief to the skin and expect the composition to smooth wrinkled skin as taught by Daiko.

#### ***Response to Arguments***

14. Applicant's arguments filed 04/13/09 have been fully considered but they are not persuasive.

15. Applicant's argues that Daiko does not remedy the deficiencies of Dubief because Daiko focuses on the novel 7-oxo-DHEA derivative and does not teach grafted polymers having a main silicone chain. The examiner disagrees. Daiko is not relied upon to teach grafted silicone polymer having silicone in the main chain because Dubief teaches grafted silicone polymer as acknowledged by applicant and as explained in paragraph 9 above that the grafted silicone polymer has silicone in the main chain, rather, Daiko is relied upon for teaching that compositions containing grafted silicone have the capability of fading out irregularities of the skin such as wrinkles and fine lines. Therefore, Daiko remedies Dubief's failure to use the composition to smooth out wrinkles and fine lines.

#### ***Double Patenting***

16. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection

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is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

17. The provisional rejection of claims 1, 6-13, 23, 25-35 and 37-46 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-35 and 1-16 and 19-21 of copending Application Nos. 10982925 and 10/508007 respectively is maintained.

18. The provisional rejection of claims 1, 6-13, 23, 25-35 and 37-46 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 60-116 and 1-59 of copending Application Nos. 10/591,583 and 10/573,579 respectively is maintained.

### ***Response to Arguments***

19. Applicant's arguments filed 4/13/09 have been fully considered but they are not persuasive.

20. Applicant requests the provisional rejections on the ground of nonstatutory obviousness-type double patenting to be held in abeyance until allowable subject matter is identified. But, the provisional obviousness type double patenting rejection is not the only rejection. Since the provisional obviousness type double patenting rejection is not the only rejection in the examined application, the rejection will continue to be made until the rejection is overcome as stated in

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MPEP 804 [R-5], I B, that "the "provisional" double patenting rejection should continue to be made by the examiner in each application as long as there are conflicting claims in more than one application unless that "provisional" double patenting rejection is the only rejection remaining in at least one of the applications." As noted above, the provisional obviousness double patenting rejection is not the only rejection remaining in this examined application. Thus rejection is maintained and is not held in abeyance.

21. No claim is allowed.

22. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BLESSING M. FUBARA whose telephone number is (571)272-0594. The examiner can normally be reached on 7 a.m. to 5:30 p.m. (Monday to Thursday).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Hartley can be reached on (571) 272-0616. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Blessing M. Fubara/  
Examiner, Art Unit 1618